

REMARKS

Upon entry of the claim amendments, Claims 2-22 will be all the claims pending in the application.

Applicants have rewritten Claim 9 as an independent claim drawn to an insulation varnish. In addition, amended Claim 9 is supported by the description at page 4, lines 1-6, of the specification.

Claims 2-8, 10, and 13-20 have been amended to depend from Claim 9 and render them consistent with amended Claim 9.

New Claims 21 and 22 are supported by Examples 1-4 and the description at the paragraph bridging pages 9 and 10 of the specification.

No new matter has been added.

Referring to the text of the Office Action mailed June 2, 2004, Applicants note with appreciation the Examiner's withdrawal of the §102(e) rejection based on the Terry reference.

The §102(b) rejection presented at page 2 of the Action and the §103(a) rejection presented at page 3 of the Action, both of which are based on the Podola reference, have been rendered moot by the claim amendments. Claim 9 was not included in either rejection.

The remaining rejection is the §103(a) rejection of Claims 1-17 and 20 over the Zaopo reference in view of the Keane reference.

Applicants respectfully traverse.

Applicants' position is that the present invention belongs to the field of winding wires aimed at withstanding partial discharges, whereas the primary reference, Zaopo, is entirely silent about the resistance to partial discharge of the varnish it discloses. Furthermore, without the benefit of Applicants' present application, a person of ordinary skill in the art would attempt to solve the problem identified above by looking into the available prior art in the field of winding wires, in order to improve the partial discharge resistance at high temperature of Keane. The skilled artisan would never look into the general prior art related to varnishes that do not deal

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with the partial discharge phenomenon. Therefore, the skilled artisan would not find Zaopo, which, even though it may deal with varnishes for wires, is entirely silent about the behavior of such varnishes in the presence of partial discharges.

At the last full paragraph at page 5 of the Action and the paragraph bridging pages 6 and 7 of the Action, the Examiner states that the "withstanding partial discharges" element is not in the claims.

Amended Claim 9, however, recites that the insulation varnish enables the winding wire to withstand partial discharges. New Claims 21 and 22 further clarify this aspect of the invention. Therefore, for the reasons presented in the Amendment filed October 6, 2003, Applicants respectfully submit that the claimed invention is patentable over the combination of Zaopo and Keane.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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